



## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application No.	09/528,466
Filing Date	March 17, 2000
First Named Inventor	Steven R Mitchell
Art Unit	3625
Examiner Name	Robert M. Pond
Attorney Docket Number	4576P001
Total Number of Pages in This Submission	10

### ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> PTO/SB/08 <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Basic Filing Fee <input type="checkbox"/> Declaration/POA <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <div>Return Receipt Postcard</div>
Remarks		

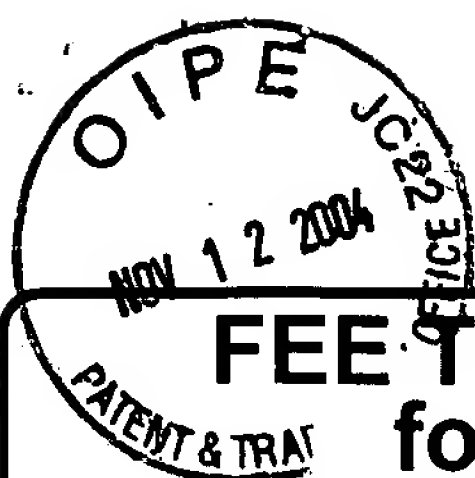
### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Jonathan S. Miller, Reg. No. 48,534 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Signature	
Date	November 9, 2004

### CERTIFICATE OF MAILING/TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Typed or printed name	Lillian E. Rodriguez		
Signature		Date	November 9, 2004



# FEE TRANSMITTAL for FY 2004

Effective 10/01/2004. Patent fees are subject to annual revision.

## Complete if Known

Application Number	09/528,466
Filing Date	March 17, 2000
First Named Inventor	Steven R Mitchell
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☒ Applicant claims small entity status. See 37 CFR 1.27.

TOTAL AMOUNT OF PAYMENT (\$) 0.00

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☒ None  
☒ Deposit Account

Deposit Account Number: 02-2666  
Deposit Account Name: Blakely, Sokoloff, Taylor & Zafman LLP

The Commissioner is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments  
☒ Charge any additional fee(s) or underpayment of fees as required under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20.  
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	FeePaid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	790	2001	395	Utility filing fee	
1002	350	2002	175	Design filing fee	
1003	550	2003	275	Plant filing fee	
1004	790	2004	395	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)				(\$)	

### 2. EXTRA CLAIM FEES

Total Claims: 53 - 53\* = 0 X 9.00 = \$0.00  
Independent Claims: 5 - 5\* = 0 X 44.00 = \$0.00  
Multiple Dependent: =

Large Entity		Small Entity		Fee Description	FeePaid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	88	2201	44	Independent claims in excess of 3	
1203	300	2203	150	Multiple Dependent claim, if not paid	
1204	88	2204	44	**Reissue independent claims over original patent	
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)				(\$)	0.00

\*\*or number previously paid, if greater, For Reissues, see below

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	FeePaid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
2053	130	2053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920 *	1804	920 *	Requesting publication of SIR prior to Examiner action	
1805	1,840 *	1805	1,840 *	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	430	2252	215	Extension for reply within second month	
1253	980	2253	490	Extension for reply within third month	
1254	1,530	2254	765	Extension for reply within fourth month	
1255	2,080	2255	1,040	Extension for reply within fifth month	
1404	340	2401	170	Notice of Appeal	
1402	340	2402	170	Filing a brief in support of an appeal	
1403	300	2403	150	Request for oral hearing	
1451	1,510	2451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,370	2453	685	Petition to revive - unintentional	
1501	1,370	2501	685	Utility issue fee (or reissue)	
1502	490	2502	245	Design issue fee	
1503	660	2503	330	Plant issue fee	
1460	130	2460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	790	1809	395	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) \_\_\_\_\_

\* Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

(\$)

## SUBMITTED BY

## Complete (if applicable)

Name (Print/Type)	Jonathan S. Miller	Registration No. (Attorney/Agent)	48,534	Telephone	(310) 207-3800
Signature		Date	11/09/04		



AF/3625  
ETW

Attorney's Docket No. 4576P001

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application for:

**Steven R. Mitchell**

Serial No. 09/528,466

Filed: March 17, 2000

For: A PURCHASE COORDINATOR FOR  
ELECTRONIC COMMERCE

Examiner: Robert M. Pond

Art Unit: 3625

Box AF  
Assistant Commissioner for Patents  
Washington, D.C. 20231

**REPLY BRIEF**

Dear Sir:

Applicant submits the following Reply Brief pursuant to 37 C.F.R. § 41.41.

**STATEMENT OF ISSUES**

The Examiner notes that Issue B in the Statement of Issues is incorrect. The Examiner correctly notes that the rejection of the claims is based on § 102(e) and not § 102(b). As the Examiner correctly surmises, this is a typographical error in the Statement of Issues. The subsequent discussion of this rejection in the Arguments Section is correctly based on § 102(e) and not § 102(b).

**GROUPING OF CLAIMS**

The Examiner disagrees with the Appellant's statement that the identified groups of claims do not stand or fall together. However, each of these groups of claims have a separate ground for rejection. Thus, the claims of any one of these groups may be found patentable separately from the claims of the other groups. For example, the Examiner has argued that the Declaration does not establish conception of certain claims. Thus, it is possible that claims in different groups may be

found to be patentable because the Declaration is sufficient for those groups while other groups may have their rejections affirmed because the declaration is not sufficient for claims in those groups.

### **ARGUMENT**

The Examiner has raised new points of argument in the Examiner's Answer regarding the non-statutory subject matter rejection of claims 1-41 and 53 and the sufficiency of the Declaration relating to conception and diligence. The Examiner sets forth the following arguments in the Examiner's Answer:

Claims 1-41 and 53 are not tied to any technological art; a reason as to why Documents A-D, L and M were not previously presented has not been provided; the Declaration under 37 C.F.R. § 1.131 contains gaps in diligence; insufficiency of Document A as evidence of conception. In response to these points of arguments, the Applicant replies as follows:

I. **Regarding the Rejection for Claims 1-41 and 53 Under 35 U.S.C. § 101**

Appellant notes that the Examiner's Answer ignores the arguments set forth in Section VIII.A of the Appeal Brief. Namely, the Examiner has failed to set forth how the Examiner is construing the claims as required by MPEP § 2106. The Examiner has not responded to the Applicant's argument set forth in the Appeal Brief discussing the holding of *State Street Bank and Trust Company v. Signature Financial*, 149 F.3d 1368 (Fed. Cir. 1998). Instead, the Examiner has cited a case, *ex parte Bowman*, 61 USPQ2d 1669, that the Examiner acknowledges is not precedential. Obviously, a non-precedential opinion has no authority. Further the analysis set forth in *Bowman*, which the Examiner purports to reference for its analysis is inapposite to the present case.

*Bowman* discusses an application where the invention "as disclosed and claimed" was written by the Applicant in that case such that it "carefully avoided tying the disclosed and the claimed invention to any technological art or environment." That is not the case with the present application. The disclosure of the present application clearly sets forth the context of the claimed

invention. Namely, that the claimed methods operate in the context of a computer environment to manipulate data. Thus, the claims which are interpreted in light of this disclosure clearly have an application in the technological arts and meet the standards as set forth in *State Street*.

II. **Issues Common to the Rejection of Groups I-IV Explanation of New Documents in Support of the Declaration**

Appellant notes that the Examiner has still not provided any authority for requesting an explanation as to why documents A-D, L and M were not utilized in preparing previous Declarations. It is unclear to the Appellant what the relevancy is for this line of questioning. As set forth in the Appeal Brief, the selection of documents used in support of a Declaration is at the Appellant's discretion. Appellant is not aware of a requirement that all the documents available to the Appellant be utilized in support of a Declaration.

Further, Appellant on multiple occasions stated to the Examiner that due to the history of the development of the invention many of the documents relating to the early stages of the invention and its conception are located and stored in machines that are no longer in use and difficult for the Appellant to search through to find relevant documents. Previously submitted Declarations utilized documentation made available at the time by the Appellant's search through this disorganized set of stored file. Due to the bulk and poor state of these files, identifying files relevant or useful for supporting a Declaration was a tedious and time consuming task. Because previous Declarations were not admitted by the Examiner, continued search for supporting documents was made thereby eventually uncovering documents A-D, L and M. Appellant provides this information for the sake of minimizing the present issues in the Appeal. Appellant restates that he believes that the Examiner has failed to set forth any rationale for requiring this information. In fact, the Examiner has been made aware, on multiple occasions during telephone conversations, of the difficulty Appellant had in locating and identifying files relating to this invention.

### III. Gaps in Diligence

In page 8 and 9 of the Examiner's Answer, the Examiner sets forth a lengthy list of cases and summaries of opinions in these cases related to the requirements for a 37 C.F.R. § 1.131 Declaration. However, the Examiner does not provide any discussion as to how these requirements are not met by the present declaration.

The Examiner seems to indicate on page 9 of the Examiner's Answer that the Examiner was not able to ascertain the relevance of the evidence presented in the declaration. The Examiner states that "the Appellant did not provide the Examiner with annotation that would have been useful to the Examiner in examining the evidence." However, the Declaration clearly set forth what the relevance of each of the documents presented in support was and identified each of these documents. It is unclear to the Appellant for which aspect of these documents the Examiner requires further explanation. In addition to the discussion of the documents in the declaration, Appellant attempted to explain to the Examiner during the telephonic interview the relevancy of each of the documents that were eventually provided in support of the Declaration. Despite this explanation, the Examiner seems unable to understand the documents provided. However, these documents should be easily understandable to one of ordinary skill in the art as they are flow charts and computer code and each of these document types are commonly encountered by those of ordinary skill in the art.

### IV. Conception

The flow chart in Document A was provided as evidence of conception. The Examiner asserts that Document A does not demonstrate conception in regard to claims 18, 35 and 42. The Examiner states that the elements of "selecting one of a plurality of distributors to fill the order" is not depicted. However, this language is not limited to the use of a coordinator to select one of a plurality of distributors to fill an order. Rather, the selection of a distributor may be by a customer as depicted in Document A where the box related to the customer finding website shows conception of this element of claims 18, 35 and 42.

The Examiner states that claims 12 and 29 are not supported by Document A because they include the elements of debiting a total value after an order shipped. The Examiner states this is not depicted because this step is depicted as a "parallel step." However, Document A clearly shows a customer credit card being charged and the payment of a manufacture, distributor or retailer and/or Internet company lower on the page and thus occurring later in time than the box related to the shipment of the product. One of ordinary skill in the art would understand that the box representing the product shipment being placed higher in the page indicates that the customer credit card is charged subsequent to the product shipping. Thus, Document A is sufficient for evidencing conception of this element of claims 12 and 29.

In regard to claims 4-6, these claims depend from independent claim 1, which the Examiner has not identified as having any issue with regard to conception based on Document A. Thus, if claim 1 is found to be patentable over the cited references the dependent claims will also inherently be patentable.

In regard to claim 53, the Examiner states that Document A does not depict "receiving acknowledgement when each order ships" and "selecting one of a plurality distributors to fill each of the orders." Selection of the distributors is addressed above in regard to claims 18, 35 and 42. One of ordinary skill in the art would understand that this is standard practice in the field. Document A in the bottom two boxes shows that after the product has been shipped, shipments and related invoices are tracked. The generation of invoices and tracking information clearly shows conception of "receiving acknowledgement when each order ships" to one of ordinary skill in the art.




### CONCLUSION

For the reasons specified above, the rejection of all claims should be overturned and the claims allowed.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Dated: 11/9/04, 2004

  
Jonathan S. Miller, Reg. No. 48,534

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#### CERTIFICATE OF MAILING:

I hereby certify that this correspondence is being deposited as First Class Mail with the United States Postal Service in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on November 9, 2004.

  
Lillian E. Rodriguez

11-9-04  
November 9, 2004